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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/303,040 04/30/99 WINSLOW

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EXAMINER

HM22/1004

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PARK, H

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

10/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**Application No.  
**09/303,040**

Applicant(s)

**WINSLOW ET AL.**Examiner  
**HANKYEL T. PARK, PH.D.**Group Art Unit  
**1648**☒ Responsive to communication(s) filed on Aug 18, 2000☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 37-74 is/are pending in the application.Of the above, claim(s) 61-68 is/are withdrawn from consideration.☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 37-60 and 69-74 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1648

### **DETAILED ACTION**

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1648**.

2. Claims 37-74 are pending. Applicants elect with traverse Group I. Applicants' argument regarding rejoining of Groups I and II and also rejoining of groups III and IV is persuasive; thus, rejoined claims 37-60 and 69-74 of Groups I and II will be examined. Claims 61-68 are withdrawn as nonelected claims.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 37-60 and 69-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite in the recitation of "capable of being expressed", since the term "capable" is not a definitive term. It either expresses or doesn't.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 37-60 and 69-74 are rejected under 35 U.S.C. 112, first paragraph, because the specification, **while being enabling for** manipulation of the expression of feline CD86, feline CTLA-4 and their ligands feline CD80 and feline CD86 costimulatory molecules in order to regulate T-cell responses, through augmentation, suppression or redirection, to raise a desired immune response towards a particular feline pathogen or feline disease condition (page 2, lines 30-36), **does not reasonably provide enablement** for a recombinant virus comprising less than the all the components listed above. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Applicants have not provided any data in regards to a recombinant virus comprising one foreign nucleic acid that would function as a vaccine as defined in the specification (page 2, line 36 to page 3, line 6). Lacking any convincing evidence to the contrary, Applicants have not enabled the invention.

7. No claim is allowed.

8. Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 308-4426. All Group 1600 Fax machines will be available to receive

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transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to H. Timothy Park, Ph.D., whose telephone number is (703) 305-7255. The Examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 6:30 AM-4:00 PM, (EST). The Examiner can also be reached on alternate Wednesdays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



H. Timothy Park, Ph.D.  
September 30, 2000

HANKYEL T. PARK, PH.D  
PRIMARY EXAMINER